



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,094	03/23/2006	Simon Reginald Hall	9276/HO-P03188USO	6440
26271	7590	05/26/2009		
FULBRIGHT & JAWORSKI, LLP			EXAMINER	
1301 MCKINNEY			SAYALA, CHHAYA D	
SUITE 5100				
HOUSTON, TX 77010-3095			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			05/26/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,094

Applicant(s)

HALL, SIMON REGINALD

Examiner

C. SAYALA

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8, 10, 11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8, 10, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 3-8, 10-11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 is indeterminate in scope. The claim recites a "driver" based on the protein energy. The metes and boundaries of this claim relies on the behaviour of a dog or cat, i.e. "the driver", and it is well established that cats and dogs are finicky eaters.

See the following disclosures that show this:

Levine (US Patent 6248377) @ col. 1, lines 31-35:

Unfortunately, some animals, such as cats or human infants, are notoriously finicky and may choose not to eat certain foods at all. Some animals will, however, joyfully devour one type of food on any given day but refuse to eat the same type of food the next day or the next week. This finicky behavior poses a serious expense problem for the owners of spoiled pets, as well as for the owners of old or sickly pets, which must be encouraged to eat sufficient amounts to keep them healthy.

Kealy (US Patent 3930031) @ col. 1, lines 33-37

Andersen et al. (US Patent 4892748) @ col. 7, lines 45-50.

Furthermore, it is not clear what "driver" "based upon the protein energy ratio" means when the foodstuff is "multi-component". For examination purposes, this is being broadly interpreted as the dog/cat naturally and always wanting protein as the

nutrient, although based on the above established finicky behaviour, even this is unclear. "Driver" relies on an animal's desire and behaviour, which, without more, renders these claims indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-8, 10-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foreman et al. (US Pub. 2001/0048955) taken with Jewell et al. (US Patent 6410063), WO 01/97605 and WO 01/97630 in view of Rice ("The Dog Handbook", pages 48-49, published by Barron's Educational Series, 1999), Romsos et al. (JAVMA, vol. 182(1), pp. 41-43, 1983) and further in view of Serpell ("The domestic dog", published by Cambridge University Press, pages 104-106, 1995) and Wills, Josephine ("Adult Maintenance", BSAVA Manual of Companion Animal Nutrition & Feeding Chapter 3; British Small Animal Veterinary Association 1996, pgs 44-46) taken with Stein ("Natural Healing for dogs and cats", Publishers: The Crossing Press, Inc. CA. 1993, page 54) and Smith ("The encyclopedia of North American sporting dogs", Willow Creek Press, 2002, page 82).

Foreman et al. teach offering a variety of foods to pets and teach a nutrient composition of protein 5-60% (instant claim 4 or claim 7), fat 1-50% (instant claim 7) and carbohydrate of 1-60% (claim 5). See paragraph [0032]. At col. 2, lines 23+, Jewell et al. teach a diet that contains about 0-about 20% carbohydrate, 25-70% protein and 20-70% fat which conforms to the amounts claimed herein at instant claims 4-5 and 7. Both the WO patents claim a diet for a pet that contains 20-70% fat. These patents teach the step of "providing" such a diet to the pet which inherently includes allowing it to eat. Both patents teach feeding the animal with varying contents of fat and protein. See particularly claim 15 in WO '605, which recites feeding a first pet food and a second pet food which differ in their content of one or more of fat, protein or carbohydrate. The reference of Foreman and the WO patents teach more than a single type of foodstuff being offered, thus meeting claim 1. The WO patents show at pages 4 ('605) and 5 (page 3 in WO '630) the limitations of claim 6, i.e. "kibbles", a ready-to-eat cereal product for animals. The patents do not teach providing unlimited quantities of food, i.e. self-selection, self-selection wherein the "driver" is protein and maintaining weight thereby.

The reference of Rice shows that "free-choice" feeding of dogs was a known method of feeding dogs *to prevent obesity and overeating*. At page 104 of the Serpell reference, the author shows that when a dog is offered a choice between two equally nutritious diets, it will invariably choose one over the other, probably depending on its sensory response to taste and odour, thus showing a food preference of one over the other. Such disclosure renders obvious that the practice of self-selection for animals

was already known in the art and that it helped in weight maintenance. Self-selection would reasonably suggest offering the animal a variety of foods and quantities. It would have been obvious to offer the variety of foods with differing macronutrient contents as shown by the Foreman and WO patents. Furthermore, Stein and Smith disclose that dogs and cats are carnivores (see Stein, col. 1, paragraph 3 to col. 2, paragraph 2 and Smith at col. 1, paragraphs 3-4) and require high amounts of quality protein and should be the first nutrient consideration in the food ingredients of such animals.

Additionally, in this regard, Romsos et al. disclose that animals such as rats and dogs are able to self-select their diet and are able to regulate their protein and energy intake by self-selection when allowed free-choice feeding. The dogs under this study were able to regulate their protein intake and establish a pattern in a week of the study. Rosmos states "It is well established that animals, including dogs, are able to regulate their intake of energy. When the energy density of the diet is lowered, dogs consume more food to maintain approximately the same energy intake". (Page 41). Rosmos indicates that animals when permitted to self select from 2 or more diets were offered that differed in concentration of protein, animals were able to self-select the desired concentration of protein without affecting energy intake.

Therefore, if the food containing the carbohydrate, fat and protein contents as shown by the primary references were to be offered in a free-choice feeding method so that the dogs/cats are able to self-select their diet then it can be reasonably expected that they would be driven by their protein intake/requirement, being carnivores. The reference of Wills teaches that cats often detect nutritional deficiencies in their diets and

have the ability to reject such diets, thus showing that animals opt for diets that are complete in the nutrients they need and would have been capable of self-regulating their diets based on optimal macronutrient content, which would reasonably be expected to be protein because animals discussed here are carnivorous as disclosed by Stein and Smith.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 3-8, 10-11 and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13, 15-16 of copending Application No. 10/742360. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application is drawn to an animal, the co-pending case claims "a feline animal", which is rendered obvious by the claiming of an animal.

4. Claims 3-8, 10-11 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 8 of U.S. Patent No. 10/540095 in view of Rosmos et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant claims are drawn to "providing" multi-component foodstuff, "allowing" the dog to eat, and basing the dog's selection upon the protein content of the food, the '095 also claims "providing" different compositions of food, wherein the animal selects the food and "allowing" the animal to consume the food and determining the amounts of nutrients consumed. While the '095 application does not claim the dog's selection being based on protein content of the food, Rosmos et al. teach that animals when permitted to self select from 2 or more diets that were offered that differed in concentration of protein, animals were able to self-select the desired concentration of protein without affecting energy intake, rendering obvious the instant claims in view of the '095 application.

Response to Arguments

Applicant's arguments filed 3/11/2009 have been fully considered but they are not persuasive.

Applicant's remarks at pages 5-6 traversing the rejections made under 35 USC 102 have been reviewed and are agreed with and have been withdrawn in view of the amended claims and addition of steps to claim 14.

With regard to the unexpected results discussed at page 7, applicant states that it was surprising that the animals maintained their weight even though they were offered

unlimited quantities of food by picking optimal nutrient quantities. The rejection now presented shows references that clearly suggest that animals were able to maintain their weight by regulating what they ate, that they did this when they were allowed "free choice" feeding and required a protein diet being carnivores. 'It is well settled that a patent cannot be properly granted for [an invention] which would flow naturally from the teaching of the prior art.' " American Infra-Red Radiant Co. v. Lambert Indus., Inc. , 360 F.2d 977, 986 [149 USPQ 722 (CCPA 1958)],(8th Cir.) (quoting Application of Libby, 255 F.2d 412 [118 USPQ 194 (CCPA 1958)], cert. denied, 385 U.S. 920 [151 USPQ 757] (1966).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. SAYALA/

Primary Examiner, Art Unit 1794